

REMARKS

At the time of the Office Action dated September 26, 2003, claims 1-3 and 7-10 were pending. Of those claims, claims 7-10 have been withdrawn from consideration pursuant to the provisions of 37 C.F.R. §1.142(b).

In this Amendment, claim 1 has been amended and new claims 11 and 12 have been added. Care has been exercised to avoid the introduction of new matter. Adequate support for the amendment of claim 1 as well as new claims 11 and 12 can be found in, for example, Figs. 1-3.

Claims 1 and 3 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Jiang.

In the statement of the rejection, the Examiner asserted that it would have been obvious to obtain the claimed invention based on the teaching of Jiang.

In response, Applicants have amended claim 1 to recite a circuit board having “external electrodes disposed on the back surface” and an adhesive layer extending to “cover an area of the circuit board under which all the external electrodes are disposed.”

Applicants submit that Jiang does not disclose these recitations. Applicants further submit that the asserted motivation of improving “the visual inspection and alignment and to reduce the filler particle lodging defects,” is not supportable, because Jiang itself does not show any specific motivation why a person skilled in the art would have realistically been motivated to modify the Jiang device to have an adhesive tape 108 extending to cover an area under which all external electrodes are disposed through a circuit board 104.

Thus, consideration of the teachings of Jiang would not have suggested each and every limitation of claims 1. Applicants, therefore, solicit withdrawal of the rejection of claim 1.

Dependent Claim 3.

If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Accordingly, as claim 1 is patentable for the reasons set forth above, it is submitted that dependent claim 3 which depend from claim 1 is also patentable. The Examiner's additional comments with respect to the claim do not cure the fundamental deficiencies of Jiang.

Applicants respectively traverse the rejection of claim 3 and solicits withdrawal thereof.

Claim 2 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Jiang in view of Taguchi et al.

In the statement of the rejection, the Examiner asserted that Jiang teaches substantially the entire claimed structure as applied to claim 1. However, for the reason set forth above, amended claim 1 would not have been obvious over Jiang et al. because Jiang et al. does not disclose all the limitations recited in claim 1. Moreover, the proposed combination of Jiang in view of Taguchi et al., even if it were proper, does not disclose the adhesive layer extending to “cover an area under which all the external electrodes are disposed through the circuit board.”

If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. *In re Fine, supra*. It is therefore submitted that dependent claim 2 which depends from claim 1 is also patentable.

Applicants, therefore, solicit withdrawal of the rejection of claim 2.

New Claims 11 and 12.

Applicants submit that new claims 11 and 12 is not directed to an invention that is independent or distinct from the invention originally claimed. Applicants further submit that claims 11 and 12 should be patentable for the reasons discussed for claim 1 because claims 11 and 12 also recite the adhesive layer extending to “cover an area under which all the external electrodes are disposed through the circuit board.”

Therefore, Applicants respectfully solicit favorable consideration of the claim.

Conclusion.

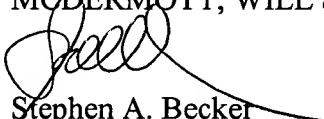
Accordingly, it is urged that the application is in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, Examiner is requested to call Applicants' attorney at the telephone number shown below.

09/665,415

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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